

REMARKS**STATUS OF APPLICATION**

No claims are canceled or added in this paper. Accordingly, claims 3, 4, 6, 8-16, 21-27, 29, and 30 are pending in the present application. No new matter has been introduced by way of the present amendment.

DRAWINGS

The indication in the Office Action, that the drawings are objected to under 37 CFR § 1.83(a) as not showing the hydraulically driven cutter of claim 27, is noted. Claim 27 has been canceled. Thus, it is believed that no drawing correction is required. It is respectfully requested that the objection to the drawings be reconsidered and withdrawn.

CLAIM OBJECTION

The objection to claim 30 as being inconsistent with claim 29, from which it depends, is noted. Claim 30 has been amended as suggested by the Examiner to overcome the objection. Thus, it is respectfully requested that the objection to claim 30 be reconsidered and withdrawn.

35 USC § 102 REJECTIONS

Claims 3, 4, 8-16, 21-25, 29, and 30 are allowable over US 4,653,776

The rejection of claims 3, 4, 8-16, 21-25, 29, and 30 under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent 4,653,776 to Borg (hereinafter referred to as "the Borg patent"), is respectfully traversed for the reasons set forth below.

Claims 3, 4, and 13 require, among other things, "a first member" and "a second member releasably attached to the first member."¹ Claim 12 requires, among other things, "a first tubular member" and "a second tubular member releasably attached to the first tubular member."² The Office Action alleges that the outer cutting tube 30 and the inner cutting tube 32 of the Borg patent are the claimed first and second members, respectively.³ If this allegation is true, which Applicant disputes, then the outer cutting tube 30 must be releasably attached to the inner cutting tube 32. The Borg patent, however, fails to teach this configuration but, rather, teaches that:

The outer cutting tube 30 is connected by screws or other fastening means to one end of a connecting sleeve 40 which fits within the tubular portion 28 of one of the termination bodies 20. The inner cutting tube 32 fits within the tubular portion 28 of the other termination body 20. Both the connecting sleeve 40 and the inner cutting tube 32 are connected by screws or other fastening means to retaining rings 42 which surround the control umbilical 10. The retaining rings are further connected by screws or other fastening means to the termination bodies 20. Thus, separation of the termination bodies 20 by the breaking of the weak link bolts 24 causes a separation of the outer cutting tube 30 and the inner cutting tube 32 such that the mating slots are closed and the opposing cutting edges sever the control hoses 14. [Emphasis added]

Thus, according to the Borg patent, the outer cutting tube 30 is not releasably attached or attached in any way to the inner cutting tube 32. Rather, the inner cutting tube 32 is disposed within the outer cutting tube 30 and, absent other structure, can move freely relative to the outer cutting tube 30. Further, the Borg patent fails to disclose or suggest the possibility or desirability for the outer cutting tube 30 to be releasably attached to the inner cutting tube 32. "The mere fact that the prior art could be so modified would not have made the modification obvious unless

¹ See lines 2-3 of each of claims 3, 4, and 13.

² See lines 2-3 of claim 12.

³ See page 3, lines 6-7, of the present Office Action.

the prior art suggested the desirability of the modification."⁴ For at least this reason, claims 3, 4, and 13 are allowable over the Borg patent.

Further, claim 3 requires, among other things, that "the first and second members are moveable in an axial direction to release from one another."⁵ Claim 12 further requires that "the first and second tubular members are moveable in an axial direction to release from one another."⁶ As discussed above, according to the Borg patent, the outer cutting tube 30 is not attached, fastened, coupled, etc. to the inner cutting tube 32 and no suggestion is provided for such a configuration. Thus, the cutting tubes 30, 32 cannot be released from one another. For at least this reason, claims 3 and 12 are allowable over the Borg patent.

Claims 3, 4, 12, and 13 are anticipated by the Borg patent, "[o]nly if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference."⁷ Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim."⁸ The Borg patent, however, falls short of these standards and, thus, claims 3, 4, 12, and 13 are allowable over the Borg patent.

Claims 8-11 depend from claim 3 and claims 14-16 depend from claim 13. Accordingly, the remarks provided above concerning claims 3 and 13 apply equally to claims 8-11 and 14-16.

Claim 21, as presently amended, requires, among other things, "releasing a first member from a second member."⁹ As discussed above concerning claims 3 and 12, according to the Borg

⁴ See *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984); *In re Brouwer*, 37 U.S.P.Q.2d (BNA) 1663, 1666 (Fed. Cir. 1995); *In re Ochiai*, 37 U.S.P.Q.2d (BNA) 1127, 1131 (Fed. Cir. 1995).

⁵ See lines 6-7 of claim 3.

⁶ See lines 4-5 of claim 12.

⁷ See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁸ See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

⁹ See line 2 of claim 21.

patent, the outer cutting tube 30 is not attached, fastened, coupled, etc. to the inner cutting tube 32. Thus, the Borg patent cannot disclose or suggest releasing the outer cutting tube 30 from the inner cutting tube 32. For at least this reason, claim 21 is allowable over the Borg patent.

Claims 22-25 depend from claim 21. Accordingly, the remarks provide above concerning claim 21 apply equally to claims 22-25.

Amended claim 29 requires, among other things, "cutting the control line with the control line cutting mechanism at the point of separation."¹⁰ The Borg patent teaches that the safety joint thereof separates between the termination body 20 and the tubular casing 28. The control hose 14, however, is cut within the tubular casing 18, not at the interface between the termination body 20 and the tubular casing 18. The Borg patent fails to suggest that cutting the control hose 14 at the interface between the termination body 20 and the tubular casing 18 is possible or even desirable. Thus, for at least these reasons, the present invention, as set forth in claim 29, is allowable over the Borg patent.

Claim 30 depends from claim 29. Accordingly, the remarks provided above concerning claim 29 apply equally to claim 30.

Accordingly, it is respectfully requested that the rejection of claims 3, 4, 8-16, 21-25, 29, and 30 under 35 U.S.C. § 102(b) as being anticipated by the Borg patent, be reconsidered and withdrawn.

35 USC § 103 REJECTIONS

Claims 6, 26, and 27 are allowable over the Borg patent

The rejection of claims 6, 26, and 27 under 35 U.S.C. § 103(a), as being unpatentable over the Borg patent, is respectfully traversed for the reasons set forth below.

Claim 6 requires, among other things, "a second member releasably attached to the first member."¹¹ As indicated above concerning claim 3, the Office Action alleges that the outer cutting tube 30 and the inner cutting tube 32 of the Borg patent are the claimed first and second members, respectively.¹² To establish a *prima facie* case of obviousness, three basic criteria must be met¹³:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, rather than merely in Applicants' disclosure, to modify the reference or to combine reference teachings;
- (2) There must be a reasonable expectation for success found in the prior art, rather than in Applicants' disclosure; and
- (3) The prior art references must teach or suggest all the claim limitations.

As discussed above concerning claim 3, the Borg patent teaches that the outer cutting tube 30 is not releasably attached or attached in any way to the inner cutting tube 32. Rather, the inner cutting tube 32 is disposed within the outer cutting tube 30 and, absent other structure, can move freely relative to the outer cutting tube 30. Further, the Borg patent fails to disclose or suggest the possibility or desirability for the outer cutting tube 30 to be releasably attached to the inner cutting tube 32. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."¹⁴ For at least this reason, claim 6 is allowable over the Borg patent.

¹⁰ See lines 8-9 of claim 29.

¹¹ See line 3 of claim 6.

¹² See page 3, lines 6-7, of the present Office Action.

¹³ See MPEP 2143 and *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

¹⁴ See *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984); *In re Brouwer*, 37 U.S.P.Q.2d (BNA) 1663, 1666 (Fed. Cir. 1995); *In re Ochiai*, 37 U.S.P.Q.2d (BNA) 1127, 1131 (Fed. Cir. 1995).

Claim 26 depends from claim 21 and requires, among other things, "releasing a first member from a second member."¹⁵ As discussed above concerning claims 3, 12, and 21, according to the Borg patent, the outer cutting tube 30 is not attached, fastened, coupled, etc. to the inner cutting tube 32. The Borg patent provides no motivation for one skilled in the art at the time of the invention to modify the Borg patent such that the outer cutting tube 30 is released from the inner cutting tube 32. Thus, claim 26 is allowable over the Borg patent.

Whether the Borg patent teaches a solenoid driven cutter, as alleged by the Office Action, is moot, as the Borg patent fails to disclose or suggest the limitations discussed above.

Claim 27 has been canceled.

Accordingly, it is respectfully requested that the rejection of claims 6, 26, and 27 under 35 U.S.C. § 103(a), as being unpatentable over the Borg patent, be reconsidered and withdrawn.

¹⁵ See line 2 of claim 21.

OFFICIAL

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to contact Daren C. Davis at (817) 578-8616 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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